

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jay S. Walker and James A. Jorasch)	Group Art Unit: 3624
)	
Application No.: 09/632,295)	Examiner: WEISBERGER, Rich
)	
Filed: August 3, 2000)	APPEAL BRIEF to Reinstate
)	Appeal & Response to
For: INSTANT CREDIT CARD)	Election/Restriction Requirement
)	
MARKETING SYSTEM)	Attorney Docket No. 96-200-C1
)	
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**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby maintain their appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Non-Final Office Action mailed August 1, 2003, rejecting Claims **60, 73-92 and 96**.

Appellants also hereby make a provisional election in response to the Examiner's requirement in the Non-Final Office Action of October 13, 2004.

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ELECTION/RESTRICTION REQUIREMENT

In the latest Office Action (mailed October 13, 2004), the Examiner has required at least one Election/Restriction of allegedly “patentably distinct species.” Specifically, the Examiner requires selection of one of the specified “GROUPs 1-7” and one of “GROUPs A-C.”

1. Provisional Elections with Traverse

Appellants provisionally elect, with traverse, the allegedly distinct GROUP I. GROUP I includes Claims **79-81, 102, and 103**.

Appellants also provisionally elect, with traverse, the allegedly distinct GROUP B. GROUP B includes Claim **120**.

For the reasons stated below, Appellants respectfully assert that the Examiner’s Election/Restrictions are improper and should be withdrawn.

2. Examiner’s Improper Basis for Requiring Election

In the present Office Action, the Examiner has required at least one Election/Restriction of allegedly “patentably distinct species” based on “further consideration of the claims, the nature of the applicant’s requests and the applicant’s remarks directed [sic] the grouping of the claims (Appeal Brief, pg. 13).” [page 2]. No combination of these alleged bases may be relied upon for requiring an election of species.

The Examiner does not provide any indication of any finding upon “further consideration of the claims” that would require election.

The Examiner does not provide any reasoning why the “nature of the applicant’s requests” now require an election of allegedly distinct species. Our “requests” in the Appeal Brief were actually arguments for reversing the Examiner’s rejection of appealed claims. It is not clear why our arguments that the Examiner failed to provide proper notice of any rejection and failed to establish any *prima facie* case for rejection is cause for an election requirement.

The Examiner also does not provide any reasoning why Appellants’ particular grouping of claims would require an election of species. The Examiner appears to be relying improperly on Appellants’ decision to provide separate arguments for patentability of claims as somehow satisfying the Examiner’s burden to establish evidence that species are patentably distinct and examination unreasonably burdensome without restriction.

That a particular asserted reference may fail to disclose different subject matter with respect to different claims (and thus provide for Appellants’ different arguments for patentability over that reference), that claims may be somehow different in scope (as they must be to be valid), and that claims may be subject to different statutory grounds for rejection (*e.g.*, some based on § 103, some on both § 103 and 112) cannot form the basis for requiring election of alleged species. Nonetheless, that is exactly what the Examiner has done by relying on Appellants’ claim groupings. Appellants’ claim groupings were determined in response to separate arguments for patentability, which were determined based on the asserted reference and the respective bases for rejection of each claim. It is not clear why Appellants’ decision to argue any claims separately on appeal would *per se* require an election between those claims. If this were so, any appeal

that provided different arguments for different claims could trigger an election restriction. It is unfair to rely solely on Appellants' groupings, especially where no evidence of unreasonable burden of examination is indicated in the record, as discussed below.

3. Rejected Claims Have Already Been Examined

The Examiner has already examined and rejected each of Claims **60, 73-92 and 96**). [Office Action mailed August 1, 2003]. Many of those claims, however, are now subject to an election requirement as being directed to various species (designated GROUPs 1-7). Appellants assert that the Examiner has had ample opportunity to examine the rejected claims and that the Examiner's continued examination of those claims would place no additional burden on the Examiner than has been carried already. *See* MPEP §803. Consequently, Appellants respectfully request the withdrawal of the current Election/Restriction.

4. The Examiner has Failed to Make a *Prima Facie* Case for Election/Restriction

A proper application of a Election/Restriction requires that the Examiner make a *prima facie* case that i) the inventions are independent or distinct as claimed, and ii) the search and examination of the entire application creates a serious burden on the Examiner. *See* MPEP §803. "Examiners must provide reasons and/or examples to support conclusions...." *Id.* The Examiner has failed to provide reasons or examples as to why the inventions are independent or distinct as claims or why the examination would create a serious burden on the

Examiner. As the Examiner has failed to comply with even the minimum requirements of the MPEP as to proper application of Election/Restriction, Applicants respectfully request that the Election/Restriction be reconsidered and withdrawn.

5. A Prima Facie Case for “Independent” Restriction has not been Established

The Examiner makes no statements alleging that the claimed inventions are “independent.” However, even if the Examiner had intended to impose the restriction based on “independent” inventions, the *prima facie* burden has still not been met. Applicants respectfully point out that “independent” inventions, as defined in restriction practice, are “not connected in design, operation, or effect, MPEP §§802.01, 808.01, and are “not capable of use together.” MPEP §§808.01, 806.04. An example of “independent” inventions would be claims directed to both “a necktie and a locomotive bearing.” *See* MPEP §808.01 at Examiner Note 1; *see also*, MPEP §806.04 (“a shoe, and a locomotive bearing”). Clearly, where all currently claimed embodiments of the present invention are related to methods “to facilitate and support expert-based commerce”, no such independence exists.

6. A Prima Facie Case for “Distinct” Restriction has not been Established

Alternatively, even if the Examiner had intended to impose the restriction based on “distinct” inventions, the *prima facie* burden has still not been met. No reasons for believing the claimed inventions are “distinct” have been set forth, nor

has the Examiner complied with the second requirement of presenting reasons for insisting upon restriction.

The Examiner has failed to show that (1) that each claimed invention “has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search,” (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. *See* MPEP §808.02. Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the “distinct” theory is established. Where “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” *Id.*

7. A Prima Facie Case for Patentably Distinct Species has not been Established

Except for the statement that the decision to require election was based on Appellants’ grouping of the claims on appeal, the Examiner has not presented any statements directed to (1) how species are believed to be mutually exclusive, (2) whether species are believed to be directed to different claimed embodiments, or (3) describing how conducting a search and examining the application as a whole would be burdensome to the Examiner.

Accordingly, Appellants respectfully request reconsideration of the Election/Restriction and withdrawal of the same.

8. The Examiner has Failed to Establish an Undue Burden

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper “[i]f the search and examination of [the] entire application can be made without serious burden.” MPEP §803. Appellants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. In particular, the Examiner has failed to show that (1) there is no separate classification of the alleged species which would necessitate a separate field of search; (2) the alleged species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged species are not related to any class of invention which has achieved a separate status in the art. *See*, MPEP §808.02.

In general, Appellants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Indeed, as mentioned *supra*, such a non-burdening search has already been conducted with respect to the rejected claims (Claims **60, 73-92 and 96**). Thus, without further showing of an undue burden upon the Examiner, Appellants respectfully assert that the Examiner has failed to meet all of the requirements of the MPEP to make a proper Election/Restriction of the instant claims.

APPEAL IS REINSTATED

Although the Examiner purports to have re-opened prosecution, the Examiner does not indicate that any of the pending rejections have been withdrawn or that any new grounds of rejection have been asserted.

The Examiner expressly states that he does not agree with any of the arguments provided in the Appeal Brief of May 17, 2004. [Office Action mailed October 13, 2004].

Accordingly, we understand (i) that the Examiner has not withdrawn any of the rejections of the Office Action of August 1, 2003; (ii) that the Examiner believes that substantial evidence is of record to support a *prima facie* case for rejection of the appealed claims; and (iii) that the appealed claims are still rejected for the same reasons stated in the Office Action of October 13, 2004.

Accordingly, we hereby reinstate our appeal of the rejection of Claims **60, 73-92 and 96**.

REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, 1177 High Ridge Road, Suite 128, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and Appellants' assignee know of no interferences or appeals that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-59 and 61-69 are cancelled.

Claims **60 and 70-121** are pending in the present application.

Claims **70-72 and 93-95** have been withdrawn from consideration.

Claims **60, 73-92 and 96** are rejected and are being appealed.

Claims **97-121** are not being appealed.

STATUS OF AMENDMENTS

No Amendments were filed subsequent to the second rejection of Claim **60** or subsequent to the mailing of the Notice of Appeal on October 31, 2003.

THE REFERENCE

Discussed below is the only reference used in rejecting the appealed claims: www.CardWeb.Com.

As admitted by the Examiner, the www.CardWeb.Com reference does not disclose or suggest all of the limitations of any claim.

1. www.CardWeb.Com

The Examiner did not provide a copy of the material identified by the Examiner as “www.CardWeb.Com, Card Trek Online, ‘Sears Premier Card.’” Appellants’ understanding of the www.CardWeb.Com reference is based only on information provided by the Examiner in the Fifth Office Action, page 3.

According to the Examiner, www.CardWeb.Com teaches that Sears “routinely offers its best customers with the Sears Premier Card.” “A newly designed blue and gold credit card will replace the current ‘Sears Card’ held by customers who meet. Moreover, the reference teaches that sears sends notification of the pre-approved guaranteed premier card by mail.” [Fifth Office Action, page 3].

The Examiner does not indicate the date of publication of the www.CardWeb.Com reference, or provide any other information that may have assisted Appellants in identifying the subject matter purportedly relied upon.

The webpage addressed by <http://www.cardweb.com> does not include any indication of a “Sears Premier Card.” It does include a link identified as “Card

Trak” to <http://www.cardweb.com/cardtrak>, but that webpage also does not include any indication of a “Sears Premier Card.”

A search using the “Search” link on <http://www.cardweb.com> with the term “Sears Premier Card” provides (among others) a webpage addressed by <http://www.cardweb.com/cardtrak/news/1999/july/26a.html>. That webpage includes an article entitled “Sears Premier Card (7/26/99).”

Appellants cannot be certain that the www.CardWeb.Com reference relied upon by the Examiner is the same as the webpage <http://www.cardweb.com/cardtrak/news/1999/july/26a.html>.

Appellants presume from the title that the article on that webpage was first published on or after July 26, 1999. If the Examiner is in fact relying on this article, the www.CardWeb.Com reference is not prior art to the present application.

Some of the text of the article, provided below in full, is similar to language used by the Examiner in describing www.CardWeb.Com:

Sears, Roebuck and Co. wants to reward its best customers with the 'Sears Premier Card'. The new program is designed to recognize and reward customers who have made 'Sears Card' purchases totaling at least \$600 in the previous 12 months. A newly designed blue and gold credit card will replace the current 'Sears Card' held by customers who meet 'Sears Premier Card' purchasing criteria. Sears will begin mailing welcome kits this week. 'Premier' cardholders will also receive priority in-home service calls, special preview shopping days prior to key sales events and exclusive money-saving offers. Sears will review all 'Sears Card' accounts semi-annually to determine which customers meet the criteria for upgrades to 'Sears Premier Card'. Customers can use their 'Sears Premier Card' at all Sears department stores, Sears Hardware, Sears and Budget Rental Cars, Sears Auto Centers, Sears authorized dealer stores, HomeLife

Furniture Stores and Orchard Supply Hardware. In addition, the 'Sears Premier Card' is also accepted for purchases at Sears Shop at Home catalogs, 1-800-FLOWERS, Sears Parts and Services and for purchases made through the Sears Web site. For more information sears.com. For more information www.sears.com.

2. Subject Matter Without Support in the Record

Subject matter without support in the record is not substantial evidence.

Appellants have already disputed various assertions by the Examiner regarding subject matter without support in the record. [Appellants' Third Response, pages 9-11]. Specifically, Claim 60 was first rejected as anticipated solely by "Official Notice" of a "business method." [Second Office Action, pages 3-4]. That rejection has never been withdrawn formally, nor has Appellants' response to that rejection ever been acknowledged.

In the Fifth Office Action, the Examiner simply asserts that it would have been obvious to provide for some subject matter not taught by the www.CardWeb.Com reference. The Examiner takes "official notice" of other subject matter. The Examiner does not cite any additional reference(s) in support. [Fifth Office Action, pages 3-4].

Appellants note that the scope of the matter of which the Examiner (i) takes "official notice" or (ii) simply asserts is obvious, is limited to the substantial evidence in the record for such matter. The sole reference of record (www.CardWeb.Com) clearly does not support the Examiner's broad assertions as to what was simply "obvious" or "well known."

Accordingly, the Examiner's omnibus assertions that are not supported by the references of record lack substantial evidence, and therefore cannot be used as prior art to the present application. Only the content of the references of record that are prior art to the present application may be so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

The rejections in the Third and Fifth Office Action that improperly rely on "official notice" or what was purportedly "well known," and / or on mere conclusory statements that certain features would be obvious, are discussed herein.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims are provided below. The summaries include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification. Any such reference:

- (i) is by way of example of the claimed subject matter only;
- (ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and
- (iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Claims **60, 73 and 96** are independent.

1. Independent Claim 60

Claim **60** is directed to a method for obtaining credit for a customer. The method comprises obtaining an indication from a credit provider of a line of credit that has been established for a customer who is expected to arrive at a particular location. The credit line is then offered to the customer while the customer is at the location. The credit line also is activated as part of a chargeable event at the location. For some examples, please see Specification, page 5, lines 4-9; page 9, lines 17-20; page 17, lines 5-7.

2. Independent Claim 73

Independent Claim 73 recites limitations generally related to those of Claim 60.

Claim 73 specifically provides for offering to the customer to activate the line of credit while the customer is at the predetermined location.

3. Independent Claim 96

Independent Claim 96 recites limitations generally related to those of Claim 60.

Claim 96 specifically provides for in which the line of credit is associated with a credit card account and in which the chargeable event is associated with the credit card account. For some examples, please see Specification, page 5, lines 4-9; page 9, lines 17-20; page 17, lines 5-7.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims **60, 73-92 and 96** stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of:

- “www.CardWeb.Com, Card Trek Online, ‘Sears Premier Card’” (hereinafter “www.CardWeb.Com”),
 - (i) a copy of which has not been provided to Appellants, and
 - (ii) for which no publication date has been identified; and
- subject matter without any evidentiary support in the record

Claims **79 and 89** stand rejected under 35 U.S.C. § 112, first paragraph (“Section 112(P1)”), for reasons that are not clear.

ARGUMENTS

1. Summary of Arguments

1.1. Rejections Fail to Comply with Section 132

All of the rejections fail under Section 132 because they are so uninformative that they prevent Appellants from recognizing and seeking to counter the grounds for rejection.

With respect to the rejection under Section 112(P1), the Examiner has failed to identify which provisions of that paragraph have been violated (if any), and has not indicated any evidence that such provisions might have been violated. It is also fatally ambiguous whether the Examiner intended to provide a rejection under 35 U.S.C. § 112, second paragraph (“§ 112(P2)”), instead of or in addition to the rejection under Section 112(P1).

With respect to the rejections under Section 103(a), the Examiner has failed to identify any reference as prior art, and has again introduced subject matter without any supporting reference. Some statements in the Section 103(a) rejection are fragmentary and incomplete.

Appellants have thus been denied adequate notice of rejection, information, or references necessary for determining the propriety of continuing prosecution of the present application, and are prevented from recognizing and seeking to counter the grounds for rejection.

1.2. Claims are Not Obvious under Section 103

The Section 103(a) rejections fail for two primary reasons: the Examiner has not made a prima facie case of obviousness, and in any event no reference(s) are of record that could support a showing of obviousness.

The Examiner has inappropriately relied on mere assertions of what was “obvious” or “well known,” unsupported by any evidence of record.

1.3. Claims Comply with Section 112(P1) and Section 112(P2)

The rejections under Section 112(P1) fail because the Examiner has not identified any claim that is not adequately disclosed or enabled, or for which the best mode contemplated by the inventors is not set forth in the written description. The claims are definite under Section 112(P2). The Examiner has not made a prima facie case of failure to comply with Section 112(P1) or Section 112(P2).

Accordingly, the rejections are inappropriate and Appellants respectfully request that the rejections be reversed.

2. **Form of Appeal Brief**

In the arguments herein, limitations of the claims are indicated in *italics* and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants refer to:

- the “Fifth Office Action”: Non-Final Office Action mailed August 1, 2003);
- Appellants’ Fifth Response: Response mailed May 15, 2003;
- Appellants’ Fourth Response: Response transmitted February 3, 2003;
- the “Third Office Action”: Non-Final Office Action mailed December 3, 2002 (Paper No. 14);
- Appellants’ Third Response: Amendment and Response mailed August 29, 2002; and
- the “Second Office Action”: Non-Final Office Action mailed April 2, 2002 (Paper No. 9).

3. **Section 103(a) Rejection**

Claims **60, 73-92 and 96** stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of:

- “www.CardWeb.Com, Card Trek Online, ‘Sears Premier Card’” (hereinafter “www.CardWeb.Com”),
 - (i) a copy of which has not been provided to Appellants, and
 - (ii) for which no publication date has been identified; and
- subject matter without any evidentiary support in the record

Separate arguments against the Section 103(a) rejection are provided for separate groups of claims:

GROUP I: Claims **60, 73-78, 88, 90, and 96**

GROUP II: Claims **79-81**

GROUP III: Claims **82-84**

GROUP IV: Claim **86**

GROUP V: Claims **91 and 92**

GROUP VI: Claim **85**

GROUP VII: Claim **87**

GROUP VIII: Claim **89**

3.1. GROUP I: Claims 60, 73-78, 88, 90, and 96

GROUP I includes Claims **60, 73-78, 88, 90, and 96**.

Appellants have not been adequately informed about the scope, content, and priority of what the Examiner might be asserting against the claims of GROUP I. The rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection. The rejection of GROUP I thus fails even the minimal level of notice of rejection, information and references that must be provided under 35 U.S.C. § 132.

Although the rejection is nominally “under Section 103(a),” for several reasons Appellants are not given adequate notice as to the actual basis for rejection:

- no indication has been provided as to whether the sole asserted reference (www.CardWeb.Com) is even prior art;
- in two Office Actions, the Examiner simply has insisted, without any evidentiary support, that subject matter recited in the claims of GROUP I is obvious or “well known”; and
- statements provided in the rejection are fragmentary and incomplete.

The rejection of GROUP I is also flawed because the Examiner has not made a prima facie case of obviousness:

- the Examiner has not identified any prior art reference;
- the Examiner has not shown all limitations of any claim of GROUP I to be disclosed or suggested by any reference (or combination of references); and

- the rejection is based on improper combinations of the sole reference with unsupported subject matter and without adequate motivation in the prior art for making the proposed combinations.

Further, the claims of GROUP I cannot be deemed obvious in light of the references of record, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders the claims of GROUP I obvious.

3.1.1. Independent Claim 60

Claim **60** is directed to a method for obtaining credit for a customer. The method comprises obtaining an indication from a credit provider of a line of credit that has been established for a customer who is expected to arrive at a particular location. The credit line is then offered to the customer while the customer is at the location. The credit line also is activated as part of a chargeable event at the location.

Independent Claims **73 and 96** recite limitations generally related to those of Claim **60**. The Examiner rejects Claims **60, 73 and 96** on identical grounds. For the purposes of this appeal, arguments made herein with respect to offering a credit line are equally applicable to offering to activate a line of credit (as in Claim **73**). Claims **74-78, 88, 90** depend (directly or indirectly) from Claim **73**.

Accordingly, although independent Claim 60 is referenced in the arguments below for simplicity, the arguments are equally applicable to Claims 60, 73-78, 88, 90, and 96.

3.1.2. Advantages of Claim 60

The embodiment of Claim 60 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

In general, as discussed in the present application, the method of Claim 60 is advantageous in that it provides for *obtaining an indication from a credit provider of a line of credit that has been established for a customer who is expected to arrive at a particular location*. The present invention recognizes, in some embodiments, that some types of entities (e.g., merchant, service provider) can anticipate (i.e., expect) the arrival of a customer at a particular location. For example, some entities can anticipate (a) a customer who comes to a retail location on a periodic basis, (b) a customer who drops off goods with a merchant, for later pick up, (c) a customer who has scheduled a service in the customer's home or office, and (d) a customer who has made a reservation (e.g., for a hotel, for a rental car). [Specification, page 9, lines 2-13]. Claim 60 advantageously allows an entity to obtain (from a credit provider) an indication of a line of credit that has been established for such a customer (e.g., by the credit provider). For example, a hotel that expects a customer (e.g., the customer has made a reservation with the hotel) may receive (e.g., from an issuing bank) a plastic

credit card for the customer. [Specification, page 9, lines 17-19; page 18, lines 12-14]. In another example, a sponsoring organization receives a notification of an authorized credit line from a credit evaluation and issuing system. [Specification, page 17, lines 18-20].

The method of Claim 60 is also advantageous in that it provides for *then offering said credit line to said customer while said customer is at said location*. In this way, the customer may be offered the credit line that was established on his behalf after he arrives at the particular location at which he was expected. For example, a hotel may offer a credit card to a customer upon check-in, or at any time during the customer's stay at the hotel. [Specification, page 9, lines 19-20].

The method of Claim 60 is further advantageous in that it provides for *activating said credit line as part of a chargeable event at said location*. This provides the benefit, in some embodiments, that the customer may make a charge to the new credit line and thus activate the credit line while at the particular location. For example, an expected hotel guest may be encouraged (or even required) to use and hence activate a new credit card to pay for his current visit to a hotel, thereby providing the benefit of creating an immediate charge to the account. [See, e.g., Specification, page 17, lines 5-8].

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.1.3. No Proper Notice of Rejection of GROUP I under 35 U.S.C. § 132

The Examiner has failed to provide proper notice of rejection under Section 132. Specifically, the Examiner has failed to notify Appellants properly of the reasons for rejecting GROUP I, and has failed to indicate information or references useful in judging the propriety of continuing the prosecution of this application. Accordingly, the rejection of GROUP I does not satisfy the threshold requirements of Section 132 and must be withdrawn.

3.1.4. The Legal Standard for Section 132

35 U.S.C. § 132 (2002) provides, in relevant part:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined.

Section 132 establishes the threshold amount of information that must be provided when a claim is rejected upon examination. “Section 132 merely ensures that an applicant ‘at least be informed of the broad statutory basis for [the rejection of] his claims, so that he may determine what the issues are on which he can or should produce evidence.’ *In re Hughes*, 52 C.C.P.A. 1355, 345 F.2d 184, 185, 145 USPQ 467, 468 (1965). Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to

counter the grounds for rejection.” Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (substitution in original, citation omitted).

In Chester v. Miller, the Federal Circuit found that Section 132 “does not mandate that in order to establish prima facie anticipation, the PTO must explicitly preempt every possible response to a section 102 rejection.” The Federal Circuit also found that the appellants in that case had been provided with adequate notice: “The [Examiner-in-Chief] specified exactly which claims read on exactly what prior art. The burden thus properly was shifted to Chester to rebut the prima facie case.” Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

3.1.5. The Examiner’s Rejection Fails the Legal Standard

The Examiner’s rejection of Claim 60 is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the notice requirements of 35 U.S.C. § 132. Although the rejection is nominally “under Section 103(a),” Appellants are not given adequate notice as to the actual reasons for rejection, nor are Appellants given the information and references required to determine the propriety of continuing the prosecution of this application.

Appellants have not been provided with a copy of the sole reference (www.CardWeb.Com) asserted by the Examiner.

Further, no indication has been provided as to whether the www.CardWeb.Com reference is even prior art. Accordingly, Appellants cannot

determine whether the reference is prior art for the purposes of Section 103(a) (or Section 102). The Fifth Office Action did not indicate a publication date in the Examiner's description of the www.CardWeb.Com reference. Also, as discussed above, although Appellants have been able to identify one webpage article with language that is similar to that indicated in the Fifth Office Action (page 3), that article presumably was made available publicly on or after July 26, 1999. That date is after the effective filing date of the present Application, June 23, 1997.

Although the Examiner is not required to anticipate every response by Appellants to the purported Section 103(a) rejection, at a minimum Appellants must be provided with enough information to be able to determine whether the matter asserted in the Fifth Office Action is in fact prior to Appellants' invention. Otherwise, Appellants are precluded, for example, from determining whether the reference is prior art under any provision of Section 102, whether Appellants might swear behind the reference, etc., and thus are prevented from judging the propriety of continuing or abandoning the prosecution of the present application.

Also, in the Second and Fifth Office Actions, the Examiner simply has insisted, without any evidentiary support, that subject matter recited in Claim 60 is obvious or "well known." Claim 60 was first rejected as anticipated solely by "Official Notice" of an asserted "business method." [Second Office Action, pages 3-4]. Appellants have already disputed the propriety of relying solely on "Official Notice" regarding subject matter without support in the record. [Appellants' Third Response, pages 9-11]. That rejection has never been withdrawn formally, nor has Appellants' response to that rejection ever been acknowledged.

In the Fifth Office Action, the Examiner again simply asserts that it would have been “obvious” to provide for some features of Claim 60. The Examiner does not cite any reference(s) in support of what allegedly was “obvious.” [Fifth Office Action, pages 3-4]. Accordingly, it is not sufficiently clear exactly what prior art the Examiner is relying on for the rejection of Claim 60, or whether the Examiner is still relying on the asserted “business method” indicated in the Second Office Action. Appellants are thus denied sufficient notice as to the reasons for the rejection of Claim 60 and cannot determine the propriety of continuing or abandoning the prosecution of the present application.

Also, a statement in the Fifth Office Action (presumably regarding the rejection of Claim 60) is fragmentary and appears to be an incomplete assertion of something purportedly “obvious” at the time of Appellants’ invention. On pages 3-4, the Examiner states:

The reference fails to teach offering the line of credit while the customer is at sears or activating the line of credit as part of a chargeable event. It would have been obvious for one skilled in the art at the time to have offered the credit line increase at the sears store motivated by the desire to increase sales and the like. It would have been obvious for one skilled in the art to have imbedded this set of instructions via[.] (emphasis added)

The sentence following the above quote specifically addresses a different claim.

Accordingly, the underlined sentence fragment is not adequately clear as to the scope and content of what is being asserted as “obvious.” For instance, the failure to complete the sentence leaves it unclear as to how, where, or why “this set of instructions” would be “imbedded,” much less what such a technique would have provided for, much less whether such “imbedding” is even prior art.

It is also not clear at all to which limitation(s) of Claim **60** the sentence fragment is directed. Appellants cannot determine whether it was directed to the *offering* step, the *activating* step, both steps, or some other step of some other claim. Also, it is insufficiently clear as to whether “this set of instructions” refers to some features of Claim **60**, matter purportedly in www.CardWeb.Com, or some other unspecified matter.

Appellants can neither recognize nor attempt to counter the grounds for the rejection when they are so uninformed about the scope, content, and date of priority of what the Examiner might be asserting against Claim **60**. The rejection of Claim **60** thus fails even the minimal level of notice required under Section 132 for rejections.

In Chester v. Miller, the Federal Circuit found that “[t]he [Examiner-in-Chief] specified exactly which claims read on exactly what prior art. The burden thus properly was shifted to Chester to rebut the prima facie case.” Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990). In contrast, the present Examiner has failed to specify exactly what prior art the rejection relies upon. In fact, as noted above, no cited reference is identifiable as prior art. Further, the Examiner seems to rely upon stark statements that claimed matter is “obvious.” [See, e.g., Fifth Office Action ,last paragraph on page 3 to page 4]. Finally, the Examiner’s statement as to what was “obvious” is incomplete, and Appellants cannot determine whether all features of Claim **60** were even addressed. Whether this unsupported and unidentified matter is even “prior” to the present invention, much less whether it teaches or suggests the specific limitations of Claim **60**,

cannot be discerned from the rejection of Claim 60. This is insufficient notice under Section 132.

Also, unlike the appellants in Chester v. Miller, the present Appellants are not objecting to some failure to “preempt every possible response to a section [103(a)] rejection.” The notice provided by the Examiner in this rejection, devoid as it is of any evidence of prior art, and leaving so much doubt as to the scope and content of what might be relied upon, amounts to nothing more than a bald assertion that Claim 60 is obvious.

Such a rejection is so uninformative as to preclude any meaningful response by Appellants and to preclude any determination of the propriety of continuing the present application. The Examiner’s rejection of Claim 60 thus prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the notice requirements of Section 132.

The rejection of Claim 60 is an improper notice of rejection under 35 U.S.C. § 132 and must be withdrawn.

3.1.6. No Prima Facie Showing of Obviousness of GROUP I

The Examiner has based a rejection of GROUP I on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP I.

3.1.7. The Section 103 Rejection Fails the Notice Requirement under Section 132

As discussed in Section 3.1.3 above, the Examiner has failed to provide adequate notice for a Section 103 rejection of any Claim of GROUP I and has failed to provide information and references necessary for determining the propriety of continuing prosecution of this application.

The Examiner has failed to make a prima facie showing of obviousness of GROUP I for at least this reason.

Other reasons are discussed in detail below.

3.1.8. The Proper Legal Standard under 35 U.S.C. § 103(a)

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an unrebutted prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). The secondary considerations are also essential

components of the obviousness determination. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

When a rejection is based on a combination of references, the Examiner can satisfy the prima facie burden only by showing some objective teaching leading to the purported combination of references. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Lacking a motivation to combine references, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367 (Fed. Cir. 2000). The "PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

3.1.9. Substantial Evidence is Required of All Factual Findings

In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

Mere administrative or judicial notice of what existed in the prior art is not permitted. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

A reference must be provided to show the scope and content of the prior art. See, e.g., In re Eynde, 480 F.2d 1364, 1370 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men, and are not amenable to the taking of such notice.").

3.1.10. Absent Substantial Evidence, No Prima Facie Case Exists

To reject claims in an application under Section 103, an examiner must show an un rebutted prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a prima facie case of obviousness is upon the examiner. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993); Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

3.1.11. No Identifiable Prior Art Has Been Cited

As discussed in Section 3.1.3 above, the Examiner has not provided adequate notice of rejection because it is not clear whether the sole reference (www.CardWeb.Com) relied upon in the obviousness rejection is even prior art. Thus, no prior art reference has been identified that would suggest any of the limitations of Claim 60.

A copy of the www.CardWeb.Com reference has not been provided to Appellants.

Appellants cannot determine whether the reference is prior art for the purposes of Section 103(a) (or Section 102). Specifically, there is no indication that www.CardWeb.Com is prior art under any provision of Section 102. The Fifth Office Action did not indicate a publication date for www.CardWeb.Com.

As discussed above, Appellants have identified a webpage addressed by <http://www.cardweb.com/cardtrak/news/1999/july/26a.html>. That webpage

includes an article entitled “Sears Premier Card (7/26/99).” Some of the text of the article is similar to language used by the Examiner. However, Appellants cannot be certain that this article corresponds to the www.CardWeb.Com reference described by the Examiner.

Appellants presume from the title that the article was first made public on or after July 26, 1999. That date is after the effective filing date of the present Application, June 23, 1997, which is the filing date of U.S. Patent Application No. 08/880,404 (of which the present Application is a continuation).

If the www.CardWeb.Com reference refers to the article at <http://www.cardweb.com/cardtrak/news/1999/july/26a.html>, then www.CardWeb.Com is not a prior art reference and cannot be used against the present Application.

In any case, the Examiner has not provided a proper showing of any prior art relied upon in rejecting Claim **60**. The Examiner thus has failed to provide any evidence that any of the limitations of Claim **60** were known prior to the present invention.

Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP I.

3.1.12. No showing that any reference suggests *then offering said credit line to said customer while said customer is at said location*

The Examiner has not shown that any reference suggests *then offering said credit line to said customer while said customer is at said location*.

Factual Evidence

The Examiner does not offer any reference as teaching or suggesting *then offering said credit line to said customer while said customer is at said location*. The closest the Examiner comes is a conclusory statement: “It would have been obvious for one skilled in the art at the time to have offered the credit line increase at the sears store motivated by the desire to increase sales and the like. It would have been obvious for one skilled in the art to have imbedded this set of instructions via[.]” [Fifth Office Action, pages 3-4].

In other words, the Examiner simply has concluded that with the exception of the *obtaining* step of Claim 60, “it would have been obvious” to provide for all of the limitations recited in Claim 60.

As discussed in Section 3.1.3 above, it is not clear what the Examiner intended to convey with the sentence fragment ending in “via,” to what limitation(s) that statement was directed, or whether the statement is even prior art.

There is no evidence that the www.CardWeb.Com reference is prior art.

No further reasoning is provided for the Examiner's interpretation of the alleged prior art. The Examiner has never provided any additional findings or

clarification with respect to this feature in any other Office Action, except for the asserted “business method” outlined in the Second Office Action. As discussed in Section 3.1.3 above, it is not clear what overlap, if any, exists between the unsupported assertions in the Second and Fifth Office Actions.

These Findings Have No Support in the Record

Nothing in the Examiner’s statement approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

The Examiner acknowledges that *then offering said credit line to said customer while said customer is at said location* is not taught by www.CardWeb.Com.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest this feature. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of Claim **60**.

Thus, in summary, the Examiner has inappropriately relied upon the mere conclusory notice that “it would have been obvious” to provide for the feature of *then offering said credit line to said customer while said customer is at said location*. The Examiner otherwise has failed to provide substantial evidence to support even a prima facie case of obviousness. The rejection fails for at least this reason.

3.1.13. No showing that any reference suggests *activating said credit line as part of a chargeable event at said location*

The Examiner has not shown that any reference suggests *activating said credit line as part of a chargeable event at said location*. The closest the Examiner comes is a conclusory statement: “It would have been obvious for one skilled in the art at the time to have offered the credit line increase at the sears store motivated by the desire to increase sales and the like. It would have been obvious for one skilled in the art to have imbedded this set of instructions via[.]” [Fifth Office Action, pages 3-4].

As discussed in Section 3.1.11 above, nothing in this statement approaches substantial evidence of a suggestion in the prior art, and the Examiner has never provided any reference in support of any of the asserted subject matter. The statement cannot support a prima facie case of obviousness.

Nothing in the statement even hints at a chargeable event, much less activating a credit line as part of a chargeable event, much less activating a credit line as part of a chargeable event at a location at which a customer was expected. As discussed in Section 3.1.3 above, it is not clear what the Examiner intended to convey with the sentence fragment ending in “via,” to what limitation(s) that statement was directed, or whether the statement is even prior art.

The Examiner acknowledges that *activating said credit line as part of a chargeable event at said location* is not taught by www.CardWeb.Com, and there is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest this feature. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of Claim 60.

Thus, in summary, the Examiner has inappropriately relied upon the mere conclusory notice that “it would have been obvious” to provide for the feature of *activating said credit line as part of a chargeable event at said location*. The Examiner otherwise has failed to provide substantial evidence to support even a prima facie case of obviousness. The rejection fails for at least this reason.

3.1.14. No showing of a proper motivation to modify the reference

Each rejection, including the rejection of Claim **60**, presumably includes a modification and / or combination of the www.CardWeb.Com reference. As discussed in Sections 3.1.11 above and 3.1.3 above, there is no evidence that the www.CardWeb.Com reference is prior art.

Regardless, the Examiner simply has not shown a motivation in the prior art of record to modify and / or combine the www.CardWeb.Com reference in the manner proposed by the Examiner, or in any other manner that renders the claims obvious.

Applicable Law

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); In re Jones, 21 U.S.P.Q.2d

1941 (Fed. Cir. 1992). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis added).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would prima facie have been obvious. Id. The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997) (emphasis added).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. Id., at 1352 - 53.

No Substantial Evidence of a Motivation to Combine or Modify

The Examiner has proposed that one of ordinary skill in the art at the time the invention was made would have modified or combined the purported prior teachings of www.CardWeb.Com with the unsupported subject matter “to have offered the credit line increase at the sears store motivated by the desire to increase sales and the like.” [Fifth Office Action, pages 3-4].

The Examiner does not provide any reference in support of this asserted motivation. The Examiner otherwise has failed to provide substantial evidence to support even a prima facie case of obviousness. The rejection fails for at least this reason.

Further, the proposed motivation (“increase sales and the like”) has nothing to do with and does not even remotely suggest the desirability of providing specifically for either of the claimed steps of

- *then offering said credit line to said customer while said customer is at said location; or*
- *activating said credit line as part of a chargeable event at said location.*

The Examiner provides no reasoned explanation as to why the asserted motivation, even if it were supported in the record, would have led one having ordinary skill in the art to provide for the claimed features in particular.

Thus the Examiner has not shown a motivation in the prior art of record to combine the references in any manner that renders any claim of GROUP I obvious. The rejection fails for at least this reason.

3.1.15. Level of Skill

Applicable Law

The level of ordinary skill in the art is one of the underlying factual findings in support of an obviousness rejection. Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The skill level is one component of the inquiry for a suggestion to combine. In re Rouffet, 149 F.3d 1350, 1359 (Fed. Cir. 1998). The level of skill in the art is measured as of the time the invention was made.

Lacking a motivation to combine, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998). If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Factual Findings

Though required to do so, the Examiner has not set forth any evidence relating to the level of ordinary skill in the art at the time of invention, and has not even alleged what the level of ordinary skill in the art would be.

Also, as discussed herein, there is no evidence that the www.CardWeb.Com reference is prior art, and thus the Examiner's description of that reference cannot support a finding of the level of ordinary skill at the time the present invention was made.

The rejection fails for at least these reasons.

3.1.16. The Examiner has omitted relevant factors required by precedent

Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence. Omission of a relevant factor required

by precedent is both legal error and arbitrary agency action. In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (citing Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co., 463 U.S. 29, 43 (1983) ("an agency rule would be arbitrary and capricious if the agency...entirely failed to consider an important aspect of the problem"); Mullins v. Department of Energy, 50 F.3d 990, 992 (Fed. Cir. 1995) ("It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action.")).

As discussed in Sections 3.1.11 - 3.1.15 above, the Examiner has omitted several relevant factors required by precedent for a Section 103 rejection.

Specifically, the Examiner has failed to provide:

- (i) any evidence or reasoned finding supporting any assertion that any of the limitations of Claim 60 were known prior to the time of invention;
- (ii) any evidence or reasoned finding in support of a proper motivation to modify or combine the www.CardWeb.Com reference; and
- (iii) any reasoned finding of a level of ordinary skill in the art (or any evidentiary basis for such a finding).

All the factors (i) – (iii) are required by precedent. The omission of any one such factor constitutes a legal error, an arbitrary agency action, and a failure to provide substantial evidence of obviousness. The Examiner has thus failed to establish a prima facie case of obviousness of Claim 60.

3.1.17. The Claims of GROUP I are Allowable Over the Cited Reference

As discussed in Sections 3.1.11 - 3.1.15 above, the Examiner has failed to provide a *prima facie* showing of obviousness of the claims of GROUP I in light of the cited www.CardWeb.Com reference (or any other prior art).

In addition, no cited reference teaches or suggests all of the features of the claims of GROUP I.

In addition, no cited references could be combined or modified in any manner that would render Claim 60 obvious.

3.1.18. The reference does not suggest all of the features

As discussed in Section 3.1.11 above, no identifiable prior art has been cited as teaching any of the features of Claim 60.

As discussed in Sections 3.1.12 and 3.1.13 above, no cited reference suggests the features of:

- *then offering said credit line to said customer while said customer is at said location*
- *activating said credit line as part of a chargeable event at said location*

as recited in Claim 60.

Accordingly, no cited references, alone or in combination, teach or suggest all of the features of Claim 60.

3.1.19. No motivation to modify the reference

As discussed in Sections 3.1.14 and 3.1.15 above, the Examiner's purported finding of a suggestion in the record to make a modification of the www.CardWeb.Com reference does not in fact support any such modification, nor has the Examiner made the required finding of the level of ordinary skill.

Accordingly, there is no showing of a proper motivation to modify and / or combine the www.CardWeb.Com reference.

3.1.20. Conclusion

The Examiner has not provided Appellants with sufficient notice of the rejection of the claims of GROUP I or information and references sufficient to judge the propriety of continuing prosecution of the present application, as is required by 35 U.S.C. § 132.

The Examiner has not set forth a prima facie case of obviousness of GROUP I, the lone cited reference does not disclose or suggest all of the limitations of the claims of GROUP I, and the lone cited reference does not suggest the advantages conferred by those limitations (discussed in detail in Section 3.1.2 above).

Accordingly, for at least those reasons, the claims of GROUP I are patentable in view of the cited reference.

3.2. GROUP II: Claims 79-81

GROUP II includes dependent Claims **79-81**.

Claim **79** has been rejected. Claim **79** depends from independent Claim **73** (GROUP I). Claims **80 and 81** depend from Claim **79** (GROUP I). Thus, all of the claims of GROUP II are patentable for the same reasons that the claims of GROUP I are patentable.

The rejection of the Claim **79** is also flawed because the Examiner has not made a prima facie case of obviousness. In addition to the failures stated in Sections 3.1.11 - 3.1.15 above with respect to GROUP I:

- the Examiner has not shown that *transmitting a request for a line of credit for the customer to the credit provider* is disclosed or suggested by any reference (or combination of references).

Further, the claims of GROUP II cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders any claim of GROUP II obvious.

3.2.1. Advantages of Claim 79

The embodiment of Claim **79** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either

alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

Several advantages of Claim 79 are discussed above in Section 3.1.2 above with respect to Claim 60. Offering to activate the line of credit while the customer is at the predetermined location has advantages similar to offering the credit line to the customer.

The method of Claim 79 is further advantageous in that it provides for *transmitting a request for a line of credit for the customer to the credit provider*. The present invention, in some embodiments, thus provides the benefit that an entity (e.g., merchant, service provider) can anticipate a customer arriving at a predetermined location and can request a line of credit for that customer (from the credit provider).

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.2.2. No Proper Notice of Rejection of GROUP II under 35 U.S.C. § 132

The rejection of Claim 79 is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132. Although the rejection of Claim 79 is nominally "under Section 103(a)" for several reasons Appellants are not given adequate notice as to the actual basis for

rejection, or adequate information and references useful in determining the propriety of continuing prosecution of the present application.

3.2.3. The Examiner's Section 103 Rejection Fails the Legal Standard

As discussed in Section 3.1.3 above with respect to GROUP I, the Examiner has failed to provide proper notice of any Section 103 rejection, as required by Section 132. Those arguments are applicable equally to the claims of GROUP II.

In addition, comments directed specifically to Claim 79 are so ambiguous and devoid of any information or reference that the Examiner has failed to notify Appellants properly of any reason for rejecting GROUP II.

The Examiner states: "With respect to Claim 79, transmitting a request for a line of credit for the customer to the credit provider is inherent in the previous scenario." [Fifth Office Action, page 4].

It is fatally unclear whether "the previous scenario" refers to www.CardWeb.Com, the unsupported subject matter asserted by the Examiner on pages 3-4 ("offered the credit line increase at the sears store"), or the fragmentary statement about "imbedding." This lack of clarity is so uninformative as to make the notice fail under Section 132.

In any case, as discussed in Section 3.1.3 above, none of those statements provides adequate notice, information or references by which Appellants may

judge the propriety of continuing prosecution of the present application. The rejection fails under Section 132 for at least these reasons.

Finally, the Examiner further obscures the limited information about the rejection by implying that Claim 79 is unpatentable over unsupported subject matter that is “inherent” in unsupported subject matter that is already not identifiable prior art, not supported by any reference at all, and / or so incomplete as to be meaningless. Appellants cannot even discern the scope, content or priority of the statements provided by the Examiner, much less make any sort of determination as to what is or is not “inherent” in such statements.

The merely nominal “Section 103” rejection of GROUP II prevents Appellants from recognizing and seeking to counter the grounds for rejection, fails the requirements of 35 U.S.C. § 132, and must be withdrawn.

3.2.4. No Prima Facie Showing of Obviousness of GROUP II

The Examiner has based his rejection of GROUP II on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting his allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP II.

All of the arguments provided in Section 3.1.6 on page 40 with respect to GROUP I are equally applicable to GROUP II.

3.2.5. The Section 103 rejection fails the notice requirement under Section 132

As discussed in Section 3.2.3 on page 58, the Examiner has failed to provide adequate notice for a Section 103 rejection of any claim of GROUP II and has failed to provide information and references necessary for determining the propriety of continuing prosecution of this application. The Examiner has failed to make a prima facie showing of obviousness of GROUP II for at least this reason.

3.2.6. No showing that any reference suggests *transmitting a request for a line of credit for the customer to the credit provider*

The Examiner has not shown that any reference suggests *transmitting a request for a line of credit for the customer to the credit provider*.

Factual Evidence

The Examiner does not offer any reference as teaching or suggesting *transmitting a request for a line of credit for the customer to the credit provider*.

The closest the Examiner comes is a conclusory statement: “With respect to Claim 79, transmitting a request for a line of credit for the customer to the credit provider is inherent in the previous scenario.” [Fifth Office Action, page 4].

As discussed in Section 3.2.3 on page 58, it is not clear what the “previous scenario” is, what reference (if any) supports the “previous scenario,” or whether the “previous scenario” is even prior art.

There is no evidence that the www.CardWeb.Com reference is prior art.

These Findings Have No Support in the Record

Nothing in the Examiner’s statement approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest *transmitting a request for a line of credit for the customer to the credit provider*. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any claim of GROUP II. The rejection fails for at least this reason.

3.2.7. No showing of a proper motivation to modify the reference

Each rejection, including the rejection of Claim **79**, presumably includes a modification and / or combination of the www.CardWeb.Com reference. As discussed in Sections 3.1.11 above and 3.1.3 above, there is no evidence that the www.CardWeb.Com reference is prior art.

Regardless, the Examiner simply has not shown a motivation in the prior art of record to modify the reference in the manner proposed by the Examiner, or in any other manner that renders the claims of GROUP II obvious.

No Substantial Evidence of a Motivation to Combine or Modify

Appellants presume that the Examiner has proposed that one of ordinary skill in the art at the time the invention was made would have modified or combined the purported prior teachings of www.CardWeb.Com “to have offered the credit line increase at the sears store motivated by the desire to increase sales and the like.” [Fifth Office Action, pages 3-4].

As discussed in Section 3.1.14 above (page 49), the Examiner does not provide any reference in support of this asserted motivation. The Examiner otherwise has failed to provide substantial evidence to support even a prima facie case of obviousness. The rejection fails for at least this reason.

Further, the proposed motivation (“increase sales and the like”) has nothing to do with and does not even remotely suggest the desirability of providing specifically for

- *transmitting a request for a line of credit for the customer to the credit provider*

The Examiner provides no reasoned explanation as to why the asserted motivation, even if it were supported in the record, would have led one having ordinary skill in the art to provide for the claimed feature in particular.

Thus the Examiner has not shown a motivation in the prior art of record to combine or modify any reference in any manner that renders any claim of GROUP II obvious. The rejection fails for at least this reason.

3.3. GROUP III: Claims 82-84

GROUP III includes dependent Claims **82-84**.

Claims **82-84** have been rejected. Claims **82-84** depend from independent Claim **73** (GROUP I). Thus, all of the claims of GROUP III are patentable for the same reasons that the claims of GROUP I are patentable.

In addition to the reasons stated in Section 3.1.3 above with respect to GROUP I, the rejection of the claims of GROUP III is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132.

The rejection of GROUP III is also flawed because the Examiner has not made a prima facie case of obviousness. In addition to the failures stated in Sections 3.1.11 - 3.1.15 above with respect to GROUP I:

- the Examiner has not shown that *generating information about said customer* is disclosed or suggested by any reference (or combination of references).

Further, the claims of GROUP III cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders any claim of GROUP III obvious.

3.3.1. Claim 82

Claim **82** includes all of the limitations of independent Claim **73** (GROUP I), from which Claim **82** depends.

Claim **82** is directed to a method. The method comprises obtaining an indication from the credit provider of a line of credit that has been established for a customer arriving at a predetermined location. Activation of the line of credit is offered to the customer while the customer is at the predetermined location. The line of credit is activated as part of a chargeable event at the predetermined location. The method also comprises generating information about the customer.

Claims **83 and 84** depend from Claim **82**.

Accordingly, although Claim **82** is referenced in the arguments below for simplicity, the arguments are equally applicable to Claims **83 and 84**.

3.3.2. Advantages of Claim 82

The embodiment of Claim **82** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

Several advantages of Claim **82** are discussed above in Section 3.1.2 above with respect to Claim **60**.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.3.3. No Proper Notice of Rejection of GROUP III under 35 U.S.C. § 132

The rejection of Claim **82** is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132. Although the rejection of Claim **82** is nominally “under Section 103(a),” for several reasons Appellants are not given adequate notice as to the actual basis for rejection or information or references useful in determining the propriety of continuing prosecution of the present application.

3.3.4. The Examiner’s Rejection Fails the Legal Standard

As discussed in Section 3.1.3 above with respect to GROUP I, the Examiner has failed to provide proper notice of any Section 103 rejection, as required by Section 132. Those arguments are equally applicable to the claims of GROUP III.

In addition, comments directed specifically to Claim **82** are so ambiguous and devoid of any information or reference that the Examiner has failed to notify Appellants properly of any reason for rejecting GROUP III.

The Examiner states: “With respect to Claim 82, this limitationn is inherent in the previous scenario.” [Fifth Office Action, page 4].

As discussed in Section 3.2.2 on page 57, the Examiner's reference to the "previous scenario" is insufficient notice. It is fatally unclear whether "the previous scenario" refers to www.CardWeb.Com, the unsupported subject matter asserted by the Examiner on pages 3-4 ("offered the credit line increase at the sears store"), or the fragmentary statement about "imbedding." This lack of clarity is so uninformative as to make the notice fail under Section 132.

In any case, as discussed in Section 3.1.3 above, none of those statements provides adequate notice, information or references by which Appellants may judge the propriety of continuing prosecution of the present application. The rejection fails under Section 132 for at least that reason.

Finally, the Examiner further obscures the limited information about the rejection by implying that Claim **82** is unpatentable over unsupported subject matter that is "inherent" in asserted subject matter that is already not identifiable prior art, not supported by any reference at all, and / or so incomplete as to be meaningless. Appellants cannot even discern the scope of content of the statements provided by the Examiner, much less make any sort of determination as to what is or is not "inherent" in such statements.

The merely nominal "Section 103" rejection of GROUP III prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132.

3.3.5. No Prima Facie Showing of Obviousness of GROUP III

The Examiner has based his rejection of GROUP III on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting his allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP III.

All of the arguments provided in Section 3.1.6 on page 40 with respect to GROUP I are equally applicable to GROUP III.

3.3.6. The Section 103 rejection fails the notice requirement under Section 132

As discussed in Section 3.3.3 on page 65, the Examiner has failed to provide adequate notice for a Section 103 rejection of any claim of GROUP III and has failed to provide information and references necessary for determining the propriety of continuing prosecution of this application. The Examiner has failed to make a prima facie showing of obviousness of GROUP III for at least this reason.

3.3.7. No showing that any reference suggests *generating information about said customer*

The Examiner has not shown that any reference suggests *generating information about said customer*.

Factual Evidence

The Examiner does not offer any reference as teaching or suggesting *generating information about said customer*.

The closest the Examiner comes is a conclusory statement: “With respect to Claim 82, this limitation is inherent in the previous scenario.” [Fifth Office Action, page 4].

As discussed in Section 3.3.3 on page 65, it is not clear what the “previous scenario” is, what reference (if any) supports the “previous scenario,” or whether the “previous scenario” is even prior art.

There is no evidence that the www.CardWeb.Com reference is prior art.

These Findings Have No Support in the Record

Nothing in the Examiner’s statement approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest *generating information about said customer*. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any claim of GROUP III. The rejection fails for at least this reason.

3.3.8. No showing of a proper motivation to modify the reference

Each rejection, including the rejection of Claim **82**, presumably includes a modification and / or combination of the www.CardWeb.Com reference. As discussed in Sections 3.1.11 above and 3.1.3 above, there is no evidence that the www.CardWeb.Com reference is prior art.

Regardless, the Examiner simply has not shown a motivation in the prior art of record to modify the reference in the manner proposed by the Examiner, or in any other manner that renders the claims of GROUP III obvious.

No Substantial Evidence of a Motivation to Combine or Modify

Appellants presume that the Examiner has proposed that one of ordinary skill in the art at the time the invention was made would have modified or combined the purported prior teachings of www.CardWeb.Com “to have offered the credit line increase at the sears store motivated by the desire to increase sales and the like.” [Fifth Office Action, pages 3-4].

As discussed in Section 3.1.14 above (page 49), the Examiner does not provide any reference in support of this asserted motivation. The Examiner otherwise has failed to provide substantial evidence to support even a prima facie case of obviousness. The rejection fails for at least this reason.

Further, the proposed motivation (“increase sales and the like”) has nothing to do with and does not even remotely suggest the desirability of providing specifically for

- *generating information about said customer*

The Examiner provides no reasoned explanation as to why the asserted motivation, even if it were supported in the record, would have led one having ordinary skill in the art to provide for the claimed feature in particular.

Thus the Examiner has not shown a motivation in the prior art of record to combine or modify any reference in any manner that renders any claim of GROUP III obvious. The rejection fails for at least this reason.

3.3.9. Conclusion

The Examiner has not provided Appellants with sufficient notice of any rejection of the claims of GROUP III or information and references sufficient to judge the propriety of continuing prosecution of the present application, as is required by 35 U.S.C. § 132.

The Examiner has not set forth a prima facie case of obviousness of GROUP III, the lone cited reference does not disclose or suggest all of the limitations of the claims of GROUP III, and the lone cited reference does not suggest the advantages conferred by those limitations.

Accordingly, for at least those reasons, the claims of GROUP III are patentable.

3.4. GROUP IV

GROUP IV includes dependent Claim **86**.

Claim **86** has been rejected. Claim **86** depends from independent Claim **73** (GROUP I). Thus, all of the claims of GROUP IV are patentable for the same reasons that the claims of GROUP I are patentable.

In addition, the rejection of GROUP IV is also flawed because the Examiner has not made a prima facie case of obviousness. In addition to the failures stated in Sections 3.1.11 - 3.1.15 above with respect to GROUP I:

- the Examiner has not shown that *creating a data record indicating a credit status for the customer* is disclosed or suggested by any reference (or combination of references).

Further, the claims of GROUP IV cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders any claim of GROUP IV obvious.

3.4.1. Claim 86

Claim **86** includes all of the limitations of independent Claim **73** (GROUP I), from which Claim **86** depends.

Claim **86** is directed to a method. The method comprises obtaining an indication from the credit provider of a line of credit that has been established for a customer arriving at a predetermined location. Activation of the line of credit is offered to the customer while the customer is at the predetermined location. The line of credit is activated as part of a chargeable event at the predetermined location. The method also comprises creating a data record indicating a credit status for the customer.

3.4.2. Advantages of Claim 86

The embodiment of Claim **86** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

Several advantages of Claim **86** are discussed above in Section 3.1.2 above with respect to Claim **60**.

In addition, Claim **86** advantageously provides for *creating a data record indicating a credit status for the customer*. For example, such a record may be created by an entity (e.g., a retailer) after receiving the indication from a credit provider of a line of credit that has been established for the customer.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.4.3. No Prima Facie Showing of Obviousness of GROUP IV

The Examiner has based his rejection of GROUP IV on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting his allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP IV.

All of the arguments provided in Section 3.1.6 on page 40 with respect to GROUP I are equally applicable to GROUP IV.

3.4.4. No showing that any reference suggests *creating a data record indicating a credit status for the customer*

The Examiner has not shown that any reference suggests *creating a data record indicating a credit status for the customer*.

Factual Evidence

The Examiner does not offer any reference as teaching or suggesting *creating a data record indicating a credit status for the customer*, or even mention this feature.

The description of www.CardWeb.com and the unsupported subject matter do not suggest any such feature. [Fifth Office Action, pages 3-4].

There is no evidence that the www.CardWeb.Com reference is prior art.

These Findings Have No Support in the Record

Nothing in the Examiner's rejection approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest *creating a data record indicating a credit status for the customer*. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any claim of GROUP IV. The rejection fails for at least this reason.

3.4.5. No showing of a proper motivation to modify the reference

The Examiner has not proposed any motivation to provide for the feature of *creating a data record indicating a credit status for the customer*.

Thus the Examiner has not shown a motivation in the prior art of record to combine or modify any reference in any manner that renders any claim of GROUP IV obvious. The rejection fails for at least this reason.

3.4.6. Conclusion

The Examiner has not provided Appellants with sufficient notice of any rejection of the claims of GROUP IV or information and references sufficient to judge the propriety of continuing prosecution of the present application, as is required by 35 U.S.C. § 132.

The Examiner has not set forth a prima facie case of obviousness of GROUP IV, the lone cited reference does not disclose or suggest all of the

limitations of the claims of GROUP IV, and the lone cited reference does not suggest the advantages conferred by those limitations.

Accordingly, for at least those reasons, the claims of GROUP IV are patentable.

3.5. GROUP V

GROUP V includes dependent Claims **91 and 92**.

Claims **91 and 92** have been rejected. Claims **91 and 92** depend from independent Claim **73** (GROUP I). Thus, all of the claims of GROUP V are patentable for the same reasons that the claims of GROUP I are patentable.

In addition, the rejection of GROUP V is also flawed because the Examiner has not made a prima facie case of obviousness. In addition to the failures stated in Sections 3.1.11 - 3.1.15 above with respect to GROUP I:

- the Examiner has not shown that *transmitting to the credit provider an indication of an amount of credit for the customer* is disclosed or suggested by any reference (or combination of references).

Further, the claims of GROUP V cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders any claim of GROUP V obvious.

3.5.1. Claim 91

Claim **91** includes all of the limitations of independent Claim **73** (GROUP I), from which Claim **91** depends.

Claim **91** is directed to a method. The method comprises obtaining an indication from the credit provider of a line of credit that has been established for a customer arriving at a predetermined location. Activation of the line of credit is offered to the customer while the customer is at the predetermined location. The line of credit is activated as part of a chargeable event at the predetermined location. The method also comprises transmitting to the credit provider an indication of an amount of credit for the customer.

Claim **92** depends from Claim **91**.

Accordingly, although Claim **91** is referenced in the arguments below for simplicity, the arguments are equally applicable to Claim **92**.

3.5.2. Advantages of Claim 91

The embodiment of Claim **91** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

Several advantages of Claim **91** are discussed above in Section 3.1.2 above with respect to Claim **60**.

In addition, Claim **91** advantageously provides for *transmitting to the credit provider an indication of an amount of credit for the customer*. For example, an entity (e.g., a retailer) may request that the credit provider establish a particular amount of credit for the customer arriving at the predetermined location. [See, e.g., Specification, page 14, lines 14-16].

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.5.3. No Prima Facie Showing of Obviousness of GROUP V

The Examiner has based his rejection of GROUP V on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting his allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP V.

All of the arguments provided in Section 3.1.6 on page 40 with respect to GROUP I are equally applicable to GROUP V.

3.5.4. No showing that any reference suggests *transmitting to the credit provider an indication of an amount of credit for the customer*

The Examiner has not shown that any reference suggests *transmitting to the credit provider an indication of an amount of credit for the customer*.

Factual Evidence

The Examiner does not offer any reference as teaching or suggesting *transmitting to the credit provider an indication of an amount of credit for the customer*, or even mention this feature.

The description of www.CardWeb.com and the unsupported subject matter do not suggest any such feature. [Fifth Office Action, pages 3-4].

There is no evidence that the www.CardWeb.Com reference is prior art.

These Findings Have No Support in the Record

Nothing in the Examiner's rejection approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest *transmitting to the credit provider an indication of an amount of credit for the customer*. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any claim of GROUP V. The rejection fails for at least this reason.

3.5.5. No showing of a proper motivation to modify the reference

The Examiner has not proposed any motivation to provide for the feature of *transmitting to the credit provider an indication of an amount of credit for the customer*.

Thus the Examiner has not shown a motivation in the prior art of record to combine or modify any reference in any manner that renders any claim of GROUP V obvious. The rejection fails for at least this reason.

3.5.6. Conclusion

The Examiner has not provided Appellants with sufficient notice of any rejection of the claims of GROUP V or information and references sufficient to judge the propriety of continuing prosecution of the present application, as is required by 35 U.S.C. § 132.

The Examiner has not set forth a prima facie case of obviousness of GROUP V, the lone cited reference does not disclose or suggest all of the limitations of the claims of GROUP V, and the lone cited reference does not suggest the advantages conferred by those limitations.

Accordingly, for at least those reasons, the claims of GROUP V are patentable.

3.6. GROUP VI

GROUP VI includes dependent Claim **85**.

Claim **85** has been rejected. Claim **85** depends from independent Claim **73** (GROUP I). Thus, all of the claims of GROUP VI are patentable for the same reasons that the claims of GROUP I are patentable.

In addition, the rejection of GROUP VI is also flawed because the Examiner has not made a prima facie case of obviousness. In addition to the failures stated in Sections 3.1.11 - 3.1.15 above with respect to GROUP I:

- the Examiner has not shown that *receiving a reservation for future services from the customer* is disclosed or suggested by any reference (or combination of references); and
- the Examiner relies inappropriately on unsubstantiated “official notice.”

Further, the claims of GROUP VI cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders any claim of GROUP VI obvious.

3.6.1. Claim 85

Claim **85** includes all of the limitations of independent Claim **73** (GROUP I), from which Claim **85** depends.

Claim **85** is directed to a method. The method comprises obtaining an indication from the credit provider of a line of credit that has been established for a customer arriving at a predetermined location. Activation of the line of credit is offered to the customer while the customer is at the predetermined location. The line of credit is activated as part of a chargeable event at the predetermined location. The method also comprises receiving a reservation for future services from the customer.

3.6.2. Advantages of Claim 85

The embodiment of Claim **85** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

Several advantages of Claim **85** are discussed above in Section 3.1.2 above with respect to Claim **60**.

In addition, Claim **85** advantageously provides for *receiving a reservation for future services from the customer*. For example, in some embodiments of the present invention, the customer arriving at the predetermined location may be expected because the customer has placed an advanced reservation, such as with a hotel, car rental company, or airline. [See, e.g., Specification, page 9, lines 2-4].

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

**3.6.3. No Proper Notice of Rejection of GROUP VI under 35
U.S.C. § 132**

The rejection of Claim **85** is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132. Although the rejection of Claim **85** is nominally “under Section 103(a),” for several reasons Appellants are not given adequate notice as to the actual basis for rejection or information or references useful in determining the propriety of continuing prosecution of the present application.

As discussed in Section 3.1.3 above with respect to GROUP I, the Examiner has failed to provide proper notice of any Section 103 rejection, as required by Section 132. Those arguments are equally applicable to the claims of GROUP VI.

In addition, no information or reference is indicated that Appellants may use to determine the propriety of continuing prosecution of the present application with respect to the additional limitation recited in Claim **85**. The Examiner simply states: “the examiner takes official notice that sears offers services (e.g., home repair).” [Fifth Office Action, page 4].

There is no indication that the statement describes prior art. No reference is provided in support of this statement. Appellants cannot determine the scope, content and priority of what is being asserted against Claim **85** without a reference.

Accordingly, the rejection is so ambiguous and devoid of the necessary information or references that the Examiner has failed to notify Appellants properly of any reason for rejecting GROUP VI.

The merely nominal "Section 103" rejection of GROUP VI prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132.

3.6.4. No Prima Facie Showing of Obviousness of GROUP VI

The Examiner has based his rejection of GROUP VI on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting his allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP VI.

All of the arguments provided in Section 3.1.6 on page 40 with respect to GROUP I are equally applicable to GROUP VI.

3.6.5. The Section 103 rejection fails the notice requirement under Section 132

As discussed in Section 3.6.3 on page 83, the Examiner has failed to provide adequate notice for a Section 103 rejection of any claim of GROUP VI and has failed to provide information and references necessary for determining the propriety of continuing prosecution of this application. The Examiner has

failed to make a prima facie showing of obviousness of GROUP VI for at least this reason.

3.6.6. No showing that any reference suggests *receiving a reservation for future services from the customer*

The Examiner has not shown that any reference suggests *receiving a reservation for future services from the customer*.

Factual Evidence

The Examiner merely takes “official notice that sears offers services (e.g., home repair). Thus a customer could buy the [sic] arrange for the services in the course of the transaction.” [Fifth Office Action, page 4]. No reference supports this assertion.

It is not clear at all what “the transaction” refers to, much less how a customer could “arrange for the services in the course of the transaction.”

The Examiner does not offer any reference as teaching or suggesting *receiving a reservation for future services from the customer*, or even mention this feature.

The description of www.CardWeb.com and the unsupported subject matter do not suggest any such feature. [Fifth Office Action, pages 3-4].

There is no evidence that the www.CardWeb.Com reference is prior art.

These Findings Have No Support in the Record

Nothing in the Examiner's rejection approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

The Examiner did not provide any evidence which supports the "official notice." Thus, the Examiner's assertion clearly lacks substantial evidence support. Thus, no prima facie case of obviousness has ever been made, and without more, Appellants are entitled to a grant of patent if the claims are otherwise allowable.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest *receiving a reservation for future services from the customer*. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any claim of GROUP VI. The rejection fails for at least this reason.

3.6.7. No showing of a proper motivation to modify the reference

The Examiner has not proposed any motivation to provide for the feature of *receiving a reservation for future services from the customer*.

The Examiner simply states: "Thus a customer could buy the [sic] arrange for the services in the course of the transaction." [Fifth Office Action, page 4]. Even if the asserted subject matter were substantially supported (which Appellants dispute), the Examiner does not propose any motivation for modifying www.CardWeb.com to provide for "the transaction," much less to provide for *receiving a reservation for future services*.

Thus the Examiner has not shown a motivation in the prior art of record to combine or modify any reference in any manner that renders any claim of GROUP VI obvious. The rejection fails for at least this reason.

3.6.8. Conclusion

The Examiner has not provided Appellants with sufficient notice of any rejection of the claims of GROUP VI or information and references sufficient to judge the propriety of continuing prosecution of the present application, as is required by 35 U.S.C. § 132.

The Examiner has not set forth a prima facie case of obviousness of GROUP VI, the lone cited reference does not disclose or suggest all of the limitations of the claims of GROUP VI, and the lone cited reference does not suggest the advantages conferred by those limitations.

Accordingly, for at least those reasons, the claims of GROUP VI are patentable.

3.7. GROUP VII

GROUP VII includes dependent Claim **87**.

Claim **87** has been rejected. Claim **87** depends from independent Claim **73** (GROUP I). Thus, all of the claims of GROUP VII are patentable for the same reasons that the claims of GROUP I are patentable.

In addition, the rejection of GROUP VII is also flawed because the Examiner has not made a prima facie case of obviousness. In addition to the failures stated in Sections 3.1.11 - 3.1.15 above with respect to GROUP I:

- the Examiner has not shown that *providing at least one incentive to the customer to make a purchase at the predetermined location* is disclosed or suggested by any reference (or combination of references); and
- the Examiner relies inappropriately on unsubstantiated “official notice.”

Further, the claims of GROUP VII cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders any claim of GROUP VII obvious.

3.7.1. Claim 87

Claim **87** includes all of the limitations of independent Claim **73** (GROUP I), from which Claim **87** depends.

Claim **87** is directed to a method. The method comprises obtaining an indication from the credit provider of a line of credit that has been established for a customer arriving at a predetermined location. Activation of the line of credit is offered to the customer while the customer is at the predetermined location. The line of credit is activated as part of a chargeable event at the predetermined location.

The method also comprises providing at least one incentive to the customer to make a purchase at the predetermined location.

3.7.2. Advantages of Claim 87

The embodiment of Claim **87** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

Several advantages of Claim **87** are discussed above in Section 3.1.2 above with respect to Claim **60**.

In addition, Claim **87** advantageously provides for *providing at least one incentive to the customer to make a purchase at the predetermined location*. In some embodiments of the present invention, a customer may be offered incentives such as free hotel shows or meals, or free room nights at a hotel. For instance, the incentives may require the customer to use the card (e.g., to pay for a current visit to a hotel). [See, e.g., Specification, page 17, lines 1-8].

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.7.3. No Proper Notice of Rejection of GROUP VII under 35 U.S.C. § 132

The rejection of Claim **87** is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132. Although the rejection of Claim **87** is nominally "under Section 103(a)," for several reasons Appellants are not given adequate notice as to the actual basis for rejection or information or references useful in determining the propriety of continuing prosecution of the present application.

As discussed in Section 3.1.3 above with respect to GROUP I, the Examiner has failed to provide proper notice of any Section 103 rejection, as required by Section 132. Those arguments are equally applicable to the claims of GROUP VII.

In addition, no information or reference is indicated that Appellants may use to determine the propriety of continuing prosecution of the present application with respect to the additional limitation recited in Claim **87**. The Examiner simply states: "the examiner takes official notice that it is well known for retailers to provide incentive [sic] to the customer to make a purchase at the predetermined[.]" [Fifth Office Action, page 4].

No reference is provided in support of this statement. Appellants cannot determine the scope, content and priority of what is being asserted against Claim 87 without a reference.

Accordingly, the rejection is so ambiguous and devoid of the necessary information or references that the Examiner has failed to notify Appellants properly of any reason for rejecting GROUP VII.

The merely nominal “Section 103” rejection of GROUP VII prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132.

3.7.4. No Prima Facie Showing of Obviousness of GROUP VII

The Examiner has based his rejection of GROUP VII on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting his allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP VII.

All of the arguments provided in Section 3.1.6 on page 40 with respect to GROUP I are equally applicable to GROUP VII.

3.7.5. The Section 103 rejection fails the notice requirement under Section 132

As discussed in Section 3.7.3 on page 90, the Examiner has failed to provide adequate notice for a Section 103 rejection of any claim of GROUP VII and has failed to provide information and references necessary for determining the propriety of continuing prosecution of this application. The Examiner has failed to make a prima facie showing of obviousness of GROUP VII for at least this reason.

3.7.6. No showing that any reference suggests *providing at least one incentive to the customer to make a purchase at the predetermined location*

The Examiner has not shown that any reference suggests *providing at least one incentive to the customer to make a purchase at the predetermined location*.

Factual Evidence

The Examiner merely takes “official notice that it is well known for retailers to provide incentive [sic] to the customer to make a purchase at the predetermined[.]” [Fifth Office Action, page 4]. No reference supports this assertion.

The Examiner does not offer any reference as teaching or suggesting *providing at least one incentive to the customer to make a purchase at the predetermined location*, or even mention this feature.

The description of www.CardWeb.com and the unsupported subject matter do not suggest any such feature. [Fifth Office Action, pages 3-4].

There is no evidence that the www.CardWeb.Com reference is prior art.

These Findings Have No Support in the Record

Nothing in the Examiner's rejection approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

The Examiner based the rejections of the claims of GROUP VII on "official notice." Specifically, the Examiner took "official notice" that the subject matter recited in Claim 87 is "well known." [Fifth Office Action, page 4].

The Examiner has not provided any reference in support of the asserted subject matter. Thus, the Examiner's assertion clearly lacks substantial evidence support. Thus, no prima facie case of obviousness has ever been made, and without more, Appellants are entitled to a grant of patent if the claims are otherwise allowable.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest *providing at least one incentive to the customer to make a purchase at the predetermined location*. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any claim of GROUP VII. The rejection fails for at least this reason.

3.7.7. No showing of a proper motivation to modify the reference

The Examiner has not proposed any motivation to provide for the feature of *providing at least one incentive to the customer to make a purchase at the predetermined location*.

Thus the Examiner has not shown a motivation in the prior art of record to combine or modify any reference in any manner that renders any claim of GROUP VII obvious. The rejection fails for at least this reason.

3.7.8. Conclusion

The Examiner has not provided Appellants with sufficient notice of any rejection of the claims of GROUP VII or information and references sufficient to judge the propriety of continuing prosecution of the present application, as is required by 35 U.S.C. § 132.

The Examiner has not set forth a prima facie case of obviousness of GROUP VII, the lone cited reference does not disclose or suggest all of the limitations of the claims of GROUP VII, and the lone cited reference does not suggest the advantages conferred by those limitations.

Accordingly, for at least those reasons, the claims of GROUP VII are patentable.

3.8. GROUP VIII

GROUP VIII includes dependent Claim 89.

Claim 89 has been rejected. Claim 89 depends from independent Claim 73 (GROUP I). Thus, all of the claims of GROUP VIII are patentable for the same reasons that the claims of GROUP I are patentable.

The rejection of Claim 89 is also flawed because the Examiner has not made a prima facie case of obviousness. In addition to the failures stated in Sections 3.1.11 - 3.1.15 above with respect to GROUP I:

- the Examiner has not shown that *transmitting an indication of a guarantee for an amount in excess of the line of credit* is disclosed or suggested by any reference (or combination of references).

Further, the claims of GROUP VIII cannot be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. The prior art of record also does not contain any proper motivation to combine or modify the references in any way that renders any claim of GROUP VIII obvious.

3.8.1. Claim 89

Claim 89 includes all of the limitations of independent Claim 73 (GROUP I), from which Claim 89 depends.

Claim **89** is directed to a method. The method comprises obtaining an indication from the credit provider of a line of credit that has been established for a customer arriving at a predetermined location. Activation of the line of credit is offered to the customer while the customer is at the predetermined location. The line of credit is activated as part of a chargeable event at the predetermined location.

The method also comprises transmitting an indication of a guarantee for an amount in excess of the line of credit.

3.8.2. Advantages of Claim 89

The embodiment of Claim **89** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination). These advantages render the claimed subject matter nonobvious over any cited reference(s).

Several advantages of Claim **89** are discussed above in Section 3.1.2 above with respect to Claim **60**. Offering to activate the line of credit while the customer is at the predetermined location has advantages similar to offering the credit line to the customer.

The method of Claim **89** is further advantageous in that it provides for *transmitting an indication of a guarantee for an amount in excess of the line of credit*. The present invention, in some embodiments, provides the benefit that an entity (e.g., merchant, service provider) may offer the customer credit in addition to that offered by a credit provider (e.g., a bank). A sponsoring organization may

decide that it wants to guarantee the difference between an amount of credit it requested and the credit line authorized by the credit provider. If so, the sponsoring organization transmits a guarantee of the additional credit to the credit provider. [See, e.g., Specification, page 15, lines 1-10].

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.8.3. No Proper Notice of Rejection of GROUP VIII under 35 U.S.C. § 132

The rejection of Claim **89** is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132. Although the rejection of Claim **89** is nominally “under Section 103(a)”, for several reasons Appellants are not given adequate notice as to the actual basis for rejection, or adequate information and references useful in determining the propriety of continuing prosecution of the present application.

3.8.4. Section 103 rejection is not adequate notice of rejection

As discussed in Section 3.1.3 above with respect to GROUP I, the Examiner has failed to provide proper notice of any Section 103 rejection, as

required by Section 132. Those arguments are equally applicable to the claims of GROUP VIII.

3.8.5. No Prima Facie Showing of Obviousness of GROUP VIII

The Examiner has based his rejection of GROUP VIII on a view of the prior art that is unsupported by the record. The Examiner has not provided any evidence supporting his allegations about the scope and content of the prior art. Accordingly, the Examiner has not presented a prima facie case of obviousness of GROUP VIII.

All of the arguments provided in Section 3.1.6 on page 40 with respect to GROUP I are equally applicable to GROUP VIII.

3.8.6. The Section 103 rejection fails the notice requirement under Section 132

As discussed in Section 3.8.3 on page 97, the Examiner has failed to provide adequate notice for a Section 103 rejection of any claim of GROUP VIII and has failed to provide information and references necessary for determining the propriety of continuing prosecution of this application. The Examiner has failed to make a prima facie showing of obviousness of GROUP VIII for at least this reason.

3.8.7. No showing that any reference suggests *transmitting an indication of a guarantee for an amount in excess of the line of credit*

The Examiner has not shown that any reference suggests *transmitting an indication of a guarantee for an amount in excess of the line of credit*.

Factual Evidence

The Examiner does not offer any reference as teaching or suggesting *transmitting an indication of a guarantee for an amount in excess of the line of credit*.

There is no evidence that the www.CardWeb.Com reference is prior art.

These Findings Have No Support in the Record

Nothing in the Examiner's statement approaches substantial evidence of any suggestion in the prior art; it cannot support a prima facie case of obviousness.

There is no substantial evidence in the record that www.CardWeb.Com or any other reference would suggest *transmitting an indication of a guarantee for an amount in excess of the line of credit*. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any claim of GROUP VIII. The rejection fails for at least this reason.

3.8.8. No showing of a proper motivation to modify the reference

The Examiner has not proposed any motivation to provide for the feature of *transmitting an indication of a guarantee for an amount in excess of the line of credit*.

Thus the Examiner has not shown a motivation in the prior art of record to combine or modify any reference in any manner that renders any claim of GROUP VIII obvious. The rejection fails for at least this reason.

3.8.9. Conclusion

The Examiner has not provided Appellants with sufficient notice of any rejection of the claims of GROUP VIII or information and references sufficient to judge the propriety of continuing prosecution of the present application, as is required by 35 U.S.C. § 132.

The Examiner has not set forth a prima facie case of obviousness of GROUP VIII, the lone cited reference does not disclose or suggest all of the limitations of the claims of GROUP VIII, and the lone cited reference does not suggest the advantages conferred by those limitations.

Accordingly, for at least those reasons, the claims of GROUP VIII are patentable.

4. Section 112(P1) Rejections

Claims **79 and 89** stand rejected under 35 U.S.C. § 112, first paragraph (“Section 112(P1)”), for reasons that are not clear.

Separate arguments against the Section 103(a) rejection are provided for separate groups of claims:

GROUP A: Claim **79**

GROUP B: Claim **89**

4.1. GROUP A: Claim 79

GROUP A includes Claim 79.

Claim 79 has been rejected under § 112(P1).

The rejection of Claim 79 fails the requirements of 35 U.S.C. § 132 because

- the purported § 112 (P1) rejection (Fifth Office Action, page 2) is fatally ambiguous.

The rejection of Claim 79 is also flawed because the Examiner has not made a prima facie case of indefiniteness or lack of written description, enablement, or best mode.

4.1.1. No Proper Notice of Rejection of GROUP A under 35 U.S.C. § 132

The rejection of Claim 79 is flawed because the rejection is so uninformative it prevents Appellants from recognizing and seeking to counter the grounds for rejection, and thus fails the requirements of 35 U.S.C. § 132. Although the rejection of Claim 79 is presumably under some portion of § 112, for several reasons Appellants are not given adequate notice as to the actual basis for rejection, or adequate information and references useful in determining the propriety of continuing prosecution of the present application.

4.1.2. The Examiner's Section 112 Rejection Fails the Legal Standard

The Examiner's rejection of Claim **79** on page 2 of the Fifth Office Action is fatally unclear.

The rejection quotes § 112(P1). However, no information or explanation is provided that appears to be related in any way to the requirements of § 112(P1).

In fact, to the contrary, the Examiner only states: "With respect to claim 79, transmitting a request for a line of credit for the customer to the credit provider, it is not clear from whom the request is made." [Fifth Office Action, page 2].

The Examiner does not mention anything related to the written description, enablement, or best mode, or failings of such, such as might be informative to a rejection under § 112(P1). For at least this reason, the notice of rejection is insufficient under Section 132.

In addition, the Examiner's only comment is directed to the clarity of the claim limitation itself. It is thus fatally unclear whether Claim **79** is being rejected under 35 U.S.C. § 112, second paragraph ("§ 112(P2)"). § 112(P1) and § 112(P2) have separate requirements. This ambiguity as to the actual statutory basis for rejecting Claim **79** fails the notice requirements of Section 132.

Further, even if the Examiner mistakenly identified § 112(P1) instead of § 112(P2), the notice of rejection is still fatally uninformative. That "it is not clear from whom the request is made" does nothing to inform Appellants as to why Claim **79** is unpatentable under § 112(P2). No information is provided as to why one having ordinary skill in the art would find the scope of Claim **89**

unreasonably unclear when read in light of the Specification. The rejection is a mere unsubstantiated statement that the claim is unpatentable.

Accordingly, the rejection of Claim 79 on page 2 of the Fifth Office Action does not satisfy the threshold requirements of Section 132 and must be withdrawn.

4.1.3. The Claims Satisfy All of the Requirements of § 112(P1)

No proper notice of a rejection under § 112(P1) of Claim 79 has been provided.

The Examiner never refers to the written description of the present application, or even hints at a finding (much less a reasoned explanation) that any claimed embodiment lacks enablement, is not described, or that its best mode is not disclosed.

Accordingly, the Examiner has not presented a *prima facie* case that Claim 79 is unpatentable under § 112(P1).

For at least these reasons, the nominal § 112(P1) rejection cannot stand.

4.1.4. The Claims are Definite under § 112(P2)

No proper notice of a rejection under § 112(P2) of Claim 79 has been provided.

In addition, the proper legal standard for definiteness was not applied to Claim 79. Accordingly, the Examiner has not presented a *prima facie* case that

any claim is indefinite. In fact, applying the proper legal standard demonstrates that Claim 79 is definite.

4.1.5. The Standard for Definiteness

Compliance with § 112, second paragraph, is a question of law. Miles Lab., Inc. v. Shandon, Inc., 997 F.2d 870, 874 (Fed. Cir. 1993).

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The inquiry under § 112(P2) focuses on whether the claims, as interpreted in view of the written description, adequately perform their function of notifying the public of the scope of the patentee's right to exclude. Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 U.S.P.Q.2D 1279, 1283 (Fed. Cir. 2000).

The Federal Circuit has explained that the second paragraph of § 112 contains two requirements: First, a claim must set forth what the applicant regards as his invention; and second, it must do so with sufficient particularity and distinctness, i.e., the claim must be sufficiently “definite.” Allen Eng’g Corp. v. Bartell Indus., 299 F.3d 1336, 1348 (Fed. Cir. 2002) (citing Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1377 (Fed. Cir. 2000)). See also, MPEP § 2171.

With respect to the first requirement, the subject matter set out in a claim must be presumed, in the absence of evidence to the contrary, to be that “which

the applicant regards as his invention.” In re Moore, 439 F.2d 1232, 1235 (C.C.P.A 1971). See also, MPEP § 2172.

With respect to the second requirement: “If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” Miles Laboratories, Inc. v. Shandon, 997 F.2d 870, 875 (Fed. Cir. 1993); see also, S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1367 (Fed. Cir. 2001). The claims need set out and circumscribe a particular area with only a reasonable degree of precision and particularity. In re Moore, 58 C.C.P.A. 1042, 1046-1047 (C.C.P.A 1971).

It is impermissible in law to apply the “full, clear, concise, and exact” requirement of the first paragraph of § 112 to a claim, when that paragraph applies only to the disclosure portion of the specification, not to the claims. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1575-1576 (Fed. Cir. 1986) (citing Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 453, 227 (Fed. Cir. 1985)). See also, MPEP § 2173.02 (“Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.”).

Breadth is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 693 (C.C.P.A 1971); In re Robins, 429 F.2d 452, 458 (C.C.P.A 1970) (finding claims definite under § 112 (2) even though “[g]iving the language its broadest possible meaning...the breadth of the claims insofar as the catalyst is concerned is indeed immense.” However, ‘Breadth is not indefiniteness.’” (citation omitted, emphasis added)). See also, In re Warmerdam, 33 F.3d 1354, 1361 (Fed. Cir. 1994) (“There has been no showing that one skilled in the art

would have any particular difficulty in determining whether a machine having a memory containing data representing a bubble hierarchy is or is not within the scope of claim 5. The Board's point, that the claim leaves unclear the technique of how the memory is configured with the data, has no bearing on this issue. The claim plainly covers all such techniques."); MPEP § 2173.04.

It is impermissible in law to require that a claim "describe" the invention, which is the role of the disclosure portion of the specification, not the role of the claims. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1575-1576 (Fed. Cir. 1986) (citing Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 453, 227 (Fed. Cir. 1985)). "[I]t is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter," as it is "entirely appropriate, and consistent with § 112, to present claims to only [one] aspect." Bendix Corp. v. United States, 600 F.2d 1364, 1369 (1979). There is no requirement under § 112, second paragraph, that a claim must be "a self-contained explanation of every step. That is not the role of claims. The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant." S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1369 (Fed. Cir. 2001).

4.1.6. The Standard Used in the Rejection

The basis for rejection of Claim 79 is unclear. The Examiner asserts only that: "With respect to claim 79, transmitting a request for a line of credit for the

customer to the credit provider, it is not clear from whom the request is made.”

[Fifth Office Action, page 2].

No assertion is made that what is claimed is not regarded by Appellants as their invention.

If the Examiner is rejecting Claim 79 for indefiniteness, the Examiner might believe the claims to be indefinite solely because Claim 79 does not recite any specific entity transmitting the request.

However, this has no bearing on the issue of definiteness. The scope of Claim 79 is unambiguous.

The claims clearly cover the transmitting of a request by any entity. Whether Claim 79 is broad in this respect has no bearing on its definiteness.

The Examiner's rejection is quite similar to the rejection overturned by the Federal Circuit in In re Warmerdam, 33 F.3d 1354 (Fed. Cir. 1994). There, the Board of Patent Appeals and Interferences had rejected claim 5 as indefinite. Claim 5 (reproduced below)

5. A machine having a memory which contains data representing a bubble hierarchy generated by the method of any of Claims 1 through 4.

was believed indefinite because it did not explain "how a memory is made or produced by the steps of generating". Id., at 1361.

The Federal Circuit reversed because explanatory detail is not required to make a claim definite.

"The Board's point, that the claim leaves unclear the technique of how the memory is configured with the data, has no bearing on this issue. The claim plainly covers all such techniques. Whether such a programmed machine is new, useful, unobvious, or otherwise patentable is not at issue in this appeal, and we express no opinion thereon. Accordingly, we conclude the Board erred in sustaining the rejection of claim 5 for indefiniteness."

Id., at 1361.

By the same reasoning, pending Claim **79** is not indefinite merely because it covers many embodiments representing different entities transmitting a request for a line of credit. The claims plainly cover all such embodiments, and thus are definite.

There is no indication that the Examiner has considered Claim **79** in light of the Specification, as is required. Any rejection under § 112(P2) would fail for at least this reason.

There is no indication that the Examiner has determined the level of ordinary skill in the art, or considered Claim **79** as one having ordinary skill in the art would in light of the Specification, as is required. Any rejection under § 112(P2) would fail for at least this reason.

Accordingly, the Examiner has not set forth a prima facie case of indefiniteness of Claim **79**.

4.2. GROUP B: Claim 89

GROUP B includes dependent Claim 89. Claim 89 has been rejected under § 112(P1).

The § 112(P1) rejection of Claim 89 fails the requirements of 35 U.S.C. § 132 because

- the § 112(P1) rejection (Fifth Office Action, page 2) is so ambiguous as to fail the minimal threshold for notice of a rejection.

The rejection of Claim 89 is also flawed because the Examiner has not made a prima facie case of indefiniteness or lack of written description, enablement, or best mode.

4.2.1. Section 112 rejection is not adequate notice of rejection

The Examiner's rejection of Claim 89 on page 2 of the Fifth Office Action is fatally unclear.

The rejection quotes § 112(P1). However, no information or explanation is provided that appears to be related in any way to the requirements of § 112(P1).

In fact, to the contrary, the Examiner only states: "With respect to claim 89, transmitting an indication of a guarantee for an amount in excess of the line of credit is unduly vague. What and for whom is the guarantee?" [Fifth Office Action, page 2].

The Examiner does not mention anything related to the written description, enablement, or best mode, or failings of such, such as might be informative to a

rejection under § 112(P1). For at least this reason, the notice of rejection is insufficient under Section 132.

In addition, the Examiner's only comment is directed to the clarity of the claim limitation itself (as opposed to the written description). It is fatally unclear whether Claim 89 is being rejected under § 112(P2). § 112(P1) and § 112(P2) have separate requirements. This ambiguity as to the actual statutory basis for rejecting Claim 89 fails the notice requirements of 35 U.S.C. § 132.

Further, even if the Examiner mistakenly identified § 112(P1) instead of § 112(P2), the notice of rejection is still fatally uninformative. The stark statement that Claim 89 "is unduly vague" and does not specify what and for whom the guarantee is, does nothing to inform Appellants as to why Claim 89 is unpatentable under § 112(P2). No information is provided as to why one having ordinary skill in the art would find the scope of Claim 89 unreasonably unclear when read in light of the Specification. The rejection is a mere unsubstantiated statement that the claim is unpatentable.

Accordingly, the rejection of Claim 89 on page 2 of the Fifth Office Action does not satisfy the threshold requirements of Section 132 and must be withdrawn.

4.2.2. The Claims Satisfy All of the Requirements of § 112(P1)

No proper notice of a rejection under § 112(P1) of any of the claims of GROUP B has been provided.

The Examiner never refers to the written description of the present application, or even hints at a finding (much less a reasoned explanation) that any

claimed embodiment lacks enablement, is not described, or that its best mode is not disclosed.

Accordingly, the Examiner has not presented a *prima facie* case that Claim 89 is unpatentable under § 112(P1).

For at least these reasons, the nominal § 112(P1) rejection cannot stand.

4.2.3. The Claims are Definite

No proper notice of a rejection under § 112(P2) of Claim 89 has been provided.

In addition, the proper legal standard for definiteness was not applied to Claim 89. Accordingly, the Examiner has not presented a *prima facie* case of that any claim is indefinite. In fact, applying the proper legal standard demonstrates that Claim 89 is definite.

4.2.4. The Standard Used in the Rejection

The basis for rejection of Claim 89 is unclear. The Examiner asserts only: “With respect to claim 89, transmitting an indication of a guarantee for an amount in excess of the line of credit is unduly vague. What and for whom is the guarantee?” [Fifth Office Action, page 2].

No assertion is made that what is claimed is not regarded by Appellants as their invention.

If the Examiner is rejecting Claim 89 for indefiniteness, the Examiner believes the claims to be indefinite solely because Claim 89 is “unduly vague” because it does not detail “[w]hat and for whom is the guarantee?”

However, this has no bearing on the issue of definiteness. The scope of Claim 89 is unambiguous and not “unduly vague.”

Claim 89 clearly covers the transmitting of an indication of a guarantee for an amount in excess of the line of credit. It is clear on its face what the guarantee is: a guarantee for an amount in excess of the line of credit. The Examiner does not even hint as to why this language would be ambiguous or unclear to one of skill in the art.

It is clear that Claim 89 on its face does not specify that the guarantee is for any particular entity. Whether Claim 89 is broad in this respect has no bearing on its definiteness.

The Examiner's rejection is quite similar to the rejection overturned by the Federal Circuit in In re Warmerdam, 33 F.3d 1354 (Fed. Cir. 1994). The details of In re Warmerdam are discussed above.

By the same reasoning provided by the Federal Circuit in In re Warmerdam, pending Claim 89 is not indefinite merely because it covers many embodiments representing transmitting an indication of a guarantee of an amount of credit. Claim 89 plainly covers all such embodiments, and thus is definite.

There is no indication that the Examiner has considered Claim 89 in light of the Specification, as is required. Any rejection under § 112(P2) would fail for at least this reason.

There is no indication that the Examiner has determined the level of ordinary skill in the art, or considered Claim **89** as one having ordinary skill in the art would, as is required. Any rejection under § 112(P2) would fail for at least these reasons.

Accordingly, the Examiner has not set forth a prima facie case of indefiniteness of Claim **89**.

5. Conclusion

Thus, the Examiner's rejection of the pending claims is improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Michael Downs at 203.461.7292 or by email at Mdowns@walkerdigital.com.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,



January 14, 2005
Date

Dean P. Alderucci
Attorney for Appellants
Registration No. 40,484
Walker Digital, LLC
Dalderucci@walkerdigital.com
(203) 461-7337 /voice
(203) 461-7300 /fax

APPENDIX A – CLAIMS

Claims **60, 73-92 and 96** are being appealed.

Claims **60, 73 and 96** are independent.

60. A method for obtaining credit for a customer comprising the steps of:

obtaining an indication from a credit provider of a line of credit that has been established for a customer who is expected to arrive at a particular location;
then offering said credit line to said customer while said customer is at said location; and
activating said credit line as part of a chargeable event at said location.

73. A method comprising:
obtaining an indication from a credit provider of a line of credit that has been established for a customer arriving at a predetermined location;
offering to the customer to activate the line of credit while the customer is at the predetermined location; and
activating the line of credit as part of a chargeable event at the predetermined location.

74. The method of claim 73, in which obtaining an indication comprises:
obtaining a credit card.

75. The method of claim 74, in which the credit card is associated with the line of credit.

76. The method of claim 74, in which the credit card is associated with the customer.

77. The method of claim 74, in which offering comprises:
offering the credit card to the customer.

78. The method of claim 74, in which activating comprises:
activating the credit card.

79. The method of claim 73, further comprising:
transmitting a request for a line of credit for the customer to the credit provider.

80. The method of claim 79, in which transmitting comprises:
transmitting a request for a credit card for the customer.

81. The method of claim 79, in which transmitting comprises:
transmitting a request for a credit card account for the customer.

82. The method of claim 73, further comprising:
generating information about the customer.

83. The method of claim 82, in which the information comprises a transaction history associated with the customer.

84. The method of claim 82, further comprising:
transmitting the information about the customer to the credit provider.

85. The method of claim 73, further comprising:
receiving a reservation for future services from the customer.

86. The method of claim 73, further comprising:
creating a data record indicating a credit status for the customer.

87. The method of claim 73, further comprising:
providing at least one incentive to the customer to make a purchase at the predetermined location.

88. The method of claim 73, in which the chargeable event is a purchase.

89. The method of claim 73, further comprising:
transmitting an indication of a guarantee for an amount in excess of the line of credit.

90. The method of claim 73, in which the customer has not solicited a line of credit.

91. The method of claim 73, further comprising:
transmitting to the credit provider an indication of an amount of credit for the customer.

92. The method of claim 91, in which the line of credit is based on the amount of credit.

96. A method for obtaining credit for a customer comprising the steps of:

obtaining an indication from a credit provider of a line of credit that has been established for a customer who is expected to arrive at a particular location, in which the line of credit is associated with a credit card account;

then offering said credit line to said customer while said customer is at said location; and

activating said credit line as part of a chargeable event at said location, in which the chargeable event is associated with the credit card account.

APPENDIX B – EVIDENCE

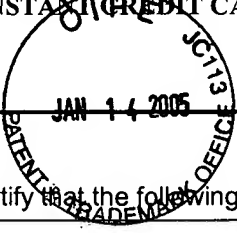
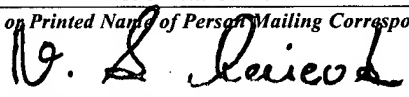
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APPENDIX C – RELATED PROCEEDINGS

<NONE>

01/18/05

Law At

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Applicant(s): JAY S. WALKER et al.				
Application No. 09/632,295	Filing Date August 3, 2000	Examiner WEISBERGER, RICHARD C	Customer No. 22927	Group Art Unit 3624
Invention: INSTANT CREDIT CARD MARKETING SYSTEM				
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